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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,215	04/12/2004	David S. Rathbun	8932-890-999	1597
20583	7590	09/22/2005		EXAMINER
JONES DAY				COMSTOCK, DAVID C
222 EAST 41ST ST				
NEW YORK, NY 10017			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/823,215	RATHBUN ET AL.
	Examiner	Art Unit
	David Comstock	3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 August 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-44,46-48 and 56-63 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 56-63 is/are allowed.

6) Claim(s) 1-4,18-22,31,32,36-40 and 46-48 is/are rejected.

7) Claim(s) 5-17,23-30,33-35 and 41-44 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 19 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1/18/05.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Caspar et al. (5,669,915; of record).

Caspar et al. disclose a drilling assembly comprising a guide barrel with a stop 20, a location post 8, and a substantially perpendicular handle (see, e.g., Fig. 1). The location post is pivotable while in the recess of the bone plate, but is also capable of being retained so as not to pivot. The post is at a distance from the guide barrel. The post is axially fixed to the alignment assembly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caspar et al. (5,669,915; of record) in view of Brace et al. (6,379,364; of record).

Caspar et al. disclose the claimed invention except for the locking post with fingers and ridges. Brace teaches the use of a locking member for use in the drilling of holes for bone plates to better secure the plate to the guide assembly and facilitate the procedure (see, e.g., Figs 1-5 and col. 4, line 32 - col. 5, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Caspar with a locking post with fingers and ridges, in view of Brace, in order to better secure the plate to the guide assembly and facilitate the procedure.

Claims 19, 31, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caspar et al. (5,669,915; of record).

Caspar et al. disclose the claimed invention except for explicitly disclosing the guide barrel having a substantially different length than the alignment assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the guide barrel to have a substantially different length than the alignment assembly, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caspar et al. (5,669,915; of record), as applied to claim 19 above, and further in view of Brace et al. (6,379,364).

Caspar et al., as modified, discloses the claimed invention except for the locking post with fingers and ridges. Brace teaches the use of a locking member for use in the

drilling of holes for bone plates to better secure the plate to the guide assembly and facilitate the procedure (see, e.g., Figs 1-5 and col. 4, line 32 - col. 5, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Caspar et al., as modified, with a locking post with fingers and ridges, in view of Brace, in order to better secure the plate to the guide assembly and facilitate the procedure.

Claims 37-40 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caspar et al. (5,669,915; of record).

Caspar et al. disclose the claimed invention except for explicitly disclosing the housing and guide barrel being integral. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them integrally, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). With regard to claims 47 and 48, it also would have been obvious to provide distances of about 0 to 0.8 mm or a 0.5 mm relative difference, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Allowable Subject Matter***

Claims 56-63 are allowed.

Claims 5-17, 23-30, 33-35 and 41-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 29 August 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the device of Caspar is not "not pivotable", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the device can be retained in place, for example, held by a user, so as to not be pivotable. Thus, it is capable of meeting the use set forth in the claim. It is also noted that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the guide barrel to have a substantially different length than the alignment assembly, since it has been held that where the general conditions of a claim are disclosed in the prior art, e.g. the components having some given length, discovering the optimum or workable ranges of each component involves only routine skill in the art.

*In re Aller*, 105 USPQ 233. Likewise, to have made the components of the device integral would merely involve routine skill in the art, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

### ***Conclusion***

Applicant's amendment, adding various limitations to the independent claims, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-

4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock  
19 September 2005



EDUARDO C. ROBERT  
PRIMARY EXAMINER